



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AE#
3727

In re application of:

WILLIAM PATRICK APPS

Serial No.: 09/785,100

Filed: February 15, 2001

For: NESTABLE DISPLAY CRATE FOR BOTTLE CARRIERS

Attorney Docket No.: RPC 0559 PUS

Group Art Unit: 3727

Examiner: S. Castellano

1 month
Extension
#19
Reply
Brief
9/10/04

02/04/2004 EFLORES 00000127 09785100

01 FC:1251

110.00 OP

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

FEB 06 2004

TECHNOLOGY CENTER R3700

Sir:

This Reply Brief is filed in reply to the Examiner's Answer mailed October 29, 2003.

Supplemental Argument

(6) Issues

Appellant does not challenge the issues as presented by the Examiner which does not substantively change the issues before the Board.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

January 29, 2004
Date of Deposit

Robert C. Brandenburg
Name of Person Signing

Signature

(10) **Grounds Of Rejection**

The Examiner suggests that the grounds for rejection were set forth in the prior Office Action Paper No. 15. However, a review of his Answer shows a significant shift of position by the Examiner. For example, in the Office Action it was stated:

Claims 1-51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Apps et al. ('461).

Apps et al. ('461) discloses a low depth nestable display crate which holds two liter beverage bottles made of polyethylene terephthalate (PET) material and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy.

Claims 15-19, 21-26, 50 and 51 are rejected under 35 U.S.C. § 102(e) as being anticipated by Apps et al. ('482).

Apps et al. ('482) discloses a low depth nestable display crate which holds beverage bottles and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

Claims 28-30, 32-39 are rejected under 35 U.S.C. § 102(b) and/or (e) as being anticipated by Koefeldt ('843).

Koefeldt ('843) discloses a low depth nestable display crate which holds one liter beverage bottles (B) in a 3 by 5 array (see Fig. 16-18) and is inherently capable of holding bottle carriers such as beverage cozys with a beer bottle in each beverage cozy or larger two-pack, four-pack, six-pack or eight-pack bottle carriers.

In the Examiner's Answer in support for his § 102 arguments, the Examiner takes the position that "Bottle carrier refers to any *hypothetically* designed bottle carrier" (Page 5, emphasis added.) He goes on to suggest this includes "a carrier of much smaller dimensions for bottles of significantly smaller dimensions or a carrier which holds only one

bottle, such as a beverage cozy. There are many bottle carriers for use with multiple bottles of 1 oz. or smaller capacity which are used in chemical test kits to test ph or ammonium levels in pool or aquarium water or to perform chemical testing in a lab.” (Page 5.) No beverage cozy or chemical test kits are disclosed by the Examiner for purposes of the rejection.

The Examiner further states in his Answer (page 5) that:

An alternate view of the prior art considers the disclosed stack of crates. The anticipatory prior art references are all nestable/stackable crates. When two or more of the crates are nested or stacked, the lower crate is deemed a crate as specified by the invention and the upper crate is a bottle carrier as specified by the invention. Each of the bottle carriers holds at least six bottles.¹

His Answer continues by making additional arguments, which were *not* found in the Office Action, regarding the references.

These are significant shifts in the Examiner’s position and require further argument by Appellant.

Similarly, the Examiner takes the position with regard to issues D and E regarding double patenting in his Answer (page 7) that “The examiner did not intend to make an obviousness-type double patenting rejection.” Despite this, he proceeds to make arguments for obviousness-type double patenting which will be addressed below.

(11) Argument

The Examiner attempts to modify the references to allege that they have the capability of holding “hypothetical” “bottle carriers.” Use of bottle carriers in the crates disclosed in the references is not taught in any of the references. This is improper:

¹ The Examiner never attempts to apply this “view” to any claim – understandably since numerous claim limitations are not met in such an application of the prior art.

For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. . . Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge **does not grant a license to read into the prior art reference teachings that are not there.**

Motorola, Inc. v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997) (emphasis added).

Since the references do not teach nor disclose any use with bottle carriers, the argument that they are inherently suitable for such use is not sustainable. Rejections must be premised on evidentiary facts, not unsupported opinion. *In re Soni*, 137 USPQ 797 (CCPA 1963).

Even if one accepts the Examiner's argument that use of bottle carriers in the references is inherent, no "beverage carriers" are disclosed in the prior art that when used with the crates of the references meet the claim language. Although use with hypothetical beverage cozies and chemical test kits is alleged, no beverage cozies and chemical test kits are disclosed so to enable Appellant or the Board to assess the allegation.

Issue A:

Apps '461 neither teaches nor discloses the claimed invention. The Examiner acknowledges a bottle carrier, as disclosed in the specification, would not fit in the Apps '461 crate. The Examiner suggests two alternatives:

First, he suggests six 1 oz. bottles in a carrier of approximately 2 inch by 3 inch dimensions would fit in the space designed for a 2-liter bottle and each bottle pocket could hold a separate carrier. Yet, the Examiner discloses no such carrier in the prior art. If one were to be found, the suggested carrier would be of such a small size that it would not extend above the lower wall portion of the '461 patent. This would not meet the claim limitation in claim

1 that there be display openings between the tooth members “wherein said display openings are sized to reveal labels on the bottle carriers for displaying the bottle carriers in a loaded crate.”

Further, the Examiner argues that “a beverage cozy designed for a 7 or 12 oz. bottle would fit the 2-liter bottle pocket.” Again, no beverage cozy is disclosed by the Examiner. Appellant does not believe one skilled in the art would recognize a beverage cozy as a bottle carrier. The definition of cozy is found in many dictionaries — all substantially similar to that found in THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 4th Edition 2000 which defines the noun cozy as “a padded or knitted covering placed especially over a teapot to keep the tea hot.” While not found in the dictionary, Appellant is aware of padded coverings for beverage cans to keep the beverage in the can cool. However, Appellant is not aware of any cozys being considered bottle carriers and does not believe those skilled in the art would so recognize a cozy as such.

Further, a padded cozy would not be inherently suitable for use in the Apps ‘461 patent. Apps ‘461 teaches that items being placed in the crate need to be seated properly for the crate to work. *See*, for example, column 1, lines 26-43; column 2, lines 1-13; column 6, lines 1-62. Placing a small bottle surrounded by a padded covering would not be suitable for use in the crate since the resultant movement of the bottle within the cozy would be intolerable in a bottle case, even if the cozy was considered a bottle carrier. The Apps ‘461 patent, as does this application, requires surfaces to maintain the bottles (in the crate of the Apps ‘461 patent) and bottle carriers (in the crate of the current application) in an upright position. Thus, the claim language requiring that the lower wall portion include “an interior bottle carrier support surface” would not be met with flexible cozys.

Since there is nothing in the Apps ‘461 that discloses and teaches the claimed inventions, the rejection under § 102 is improper.

Claims 2 and 16 further require spaced tooth members extending upward from the lower wall portion and having interior teeth panels which are flat to provide lateral support to bottle carriers loaded in the crate. The Examiner states that “the pylons 58 have flat interior surfaces capable of providing lateral support to bottle carriers.” (Page 6.) However, no flat surfaces as called for in the claims are found in the Apps’ 461 patent. As noted above, the hypothetical six 1 oz. bottle carrier would not extend above the lower wall portion so to contact any surface of pylon 58 above the lower wall portion. Assuming a cozy would extend high enough to contact a portion of the pylon above the lower wall portion, all of the surfaces of the pylons facing the pocket are concavely curved and not flat, as best seen in Figure 2. *See also*, column 6, lines 30-35 (“Pylons 58a disposed in the corners between two adjacent walls have one *curved surface* 34. Pylons 58 disposed on side walls 12, 16 have *two curved surfaces* 34 and one flat surface 36 disposed therebetween. The two curved surfaces 34 help define two separate and adjacent bottle retaining pockets 32. The flat surface 36 is disposed between these two bottle retaining pockets.” (Emphasis added.)) Amazingly, the Examiner recognizes this in his discussion regarding claim 22 where he admits that the upper edge of pylon 58 which is directed to face the bottles is concavely curved” (Page 6.) Thus, the claim limitations of claims 2 and 16 are not met.

With regard to claim 22, there is a requirement that the spaced tooth members extending along said side walls have an upper edge with at least one rounded portion. Nothing meeting this requirement is found in the Apps’ 461 patent. The Examiner argues “the upper edge of pylon 58 *which is directed to face the bottles* is concavely curved and includes a rounded portion.” (Page 6, emphasis added.) The part of pylon 58 directed to face the bottles is a side of a pylon, not an upper edge. The upper edges of the pylons, as best shown in Figure 5, are not rounded. The claim limitations of claims 22 are not met.

Claim 31 requires that the inner surface of the side wall lower portion between spaced tooth members have a plurality of ribs extending inwardly perpendicular therefrom. Though there is a rib 35 extending inwardly perpendicular from the inner surface of the outer

wall between the spaced tooth members, there is not a plurality of such ribs as claimed. The claim limitations of claim 31 are not met.

Issue B:

The Examiner's primary argument is that Apps '482 has the space to hold two or three six-pack carriers transversely oriented with respect to the crate's longitudinal axis. The Examiner also argues that Apps '482 has even more capacity than Apps '461 of holding smaller bottle carriers, designed for fewer bottles, or designed for bottles of smaller capacity.

While in hindsight certainly bottle carriers could be placed in Apps '482 (though this is not disclosed or suggested), they cannot be held there in the manner taught by Apps '482 or required by the patent claims. The claims require that the lower side wall portion have interior bottle carrier support surfaces. Any carriers placed in the open area of the Apps '482 crate would be prevented from interacting with the interior of the lower wall portion by surface 56. The Examiner states with regard to claim 16 that surface 56 forms a surface of the teeth panel that is flat and coplanar with the interior bottle surface carrier support surfaces. Due to the lack of such interior support surfaces, Apps '482 does not anticipate the claims.

Issue C:

Koefeldt '843 is said by the Examiner to have space to hold three six-pack carriers transversely oriented with respect to the crate's longitudinal axis. Koefeldt '843 is also said by the Examiner to be even more capable than Apps '461 of holding smaller bottle carriers designed for fewer bottles or designed for bottles of smaller capacity. However, for the same reasons argued above as with Apps '482, if one were to place bottle carriers as argued by the Examiner, but not taught in the patents, there exists no interior support surface that satisfies the claim language.

With regard to claim 28, the Examiner argues handle 282 shown in Figure 16 may be encircled by a user's hand and/or fingers. However, if one looks at the Figure 19,

which shows the handle of handle 282 in more detail, one can readily recognize that a hand or fingers cannot encircle the handle as required by the claim.

Claim 33 requires that teeth panels be provided on the interior side of tooth members with the panels being flat to provide lateral support to the bottle carrier surfaces loaded in the crate. The Examiner argues that panels 70 and 72 are flat and capable of providing support to the bottle carriers. However, the flat panels must be on the spaced tooth members “extending upwardly said lower wall portion” (claim 28, upon which claim 33 is dependent). Panel 70 does not extend upwardly from the lower wall panel and in fact is below the top of the lower wall portion. Panel 72 extends in an angle away from the surface of the bottle carriers as positioned by the Examiner and has a central rib 79. Thus, it would not contact the bottle carrier to provide lateral support and is not a flat panel. The limitations of claim 33 are not met.

Issue D:

In Appellant’s initial brief, Appellant showed how the Examiner did not establish a *prima facie* case of double patenting, pointing out *inter alia* that the Examiner improperly (a) treats the prior patent disclosure as prior art; (b) does not attempt to address the differences between the claims of the pending application and the claims of the reference, concentrating on their “common subject matter” in a summary fashion; and (c) fails to explain why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. Appellant also showed how the claims had significant non-obvious differences from claims 1-5 of Apps ‘654, the parent of the this application.

The Examiner bizarrely responds by stating: “The Examiner did not intend to make an obviousness-type double patenting rejection.” (Page 7.)² The Examiner then argues

² If the Examiner did not intend to issue an obviousness-type double patenting rejection, he should not have done so since that required a withdrawal of the initial appeal and delayed

for the unintended rejection but ignores the law and makes no attempt to establish a *prima facie* case. He only addresses in detail claim 1 and otherwise states that "all elements not claimed were obvious because these elements are old and well-known in the crate design." (Page 7.) And "where the claims were made broader by deleting limitations, it would have been obvious to delete these limitations and their respective functions where the functions are deemed unnecessary." (Page 8.) No basis is given for these statements and of course they are untrue. Even if one were to accept the argument that the additional elements are old and well-known in crate design, the Examiner does not even attempt to argue that the combination claimed, including those elements, is obvious in view of the prior patent as is required. Similarly, the Examiner gives no basis for his argument that the deleted limitations were obvious as part of the combination which is required as part of his *prime facie* case.

The only specific attempt by the Examiner to address the substance of the double patenting rejection is with regard to claim 1 where he states incorrectly that the only difference between claim 1 of the present invention and claim 1 of Apps '654 is that the word solid is added. (Page 7.) This ignores the recitation on page 17 of Appellant's brief where it pointed out that claim 1 in addition to adding the word "solid" (a) eliminated the Apps '654 limitation that the bottle carriers be six-packs; (b) no longer required the wall structure to be double thickness, although such a limitation continues to be directed to the upper wall portion of the wall structure in the pending claim; and (c) provided that the user's hand no longer need "completely" encircle said handlebar. As to the one change addressed, that being adding the word "solid" in line 7 of the claim, the Examiner does not address whether the change is obvious. Given that he does not address this issue nor the numerous other changes in the claim, no *prima facie* case has been established. The double patenting rejection over Apps '654 should be rejected.

the eventual issuance of the patent. Applicant has been highly prejudiced in terms of time and money by the need to respond to this unintended rejection, particularly since the double patenting rejections were the only ones added by the Examiner when he withdrew the application from the initial appeal.

Issue E:

Again, in the initial brief, Appellant on pages 19-20 went into detail as to what is required when an Examiner attempts an obvious-type double patenting between design and utility patents. No attempt is made to show the two-way test is met, *i.e.*, that the claims of each patent read on the other. Rather, the Examiner stated he had not intended to make the obvious-type double patenting rejection, as stated above. The Examiner then ignores the law and makes the irrelevant statement that "[s]ince the figures show everything in the claims and much more. The obviousness would be the deletion of those elements not necessary." (Page 8.) Since the Examiner has not met the requirements of the law to establish a *prima facie* case of double patenting, the double patenting rejection over the Apps design patent '012 should be rejected.

For the reasons discussed above, Appellant believes the recited rejections of claims 1-51 are in error. Thus, reversal is respectfully requested.

A check in the amount of \$110 for a one month extension. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 02-3978.

Respectfully submitted,

WILLIAM PATRICK APPS

By: 

Robert C. Brandenburg
Registration No. 29,048
Attorney for Appellant

Date: 1/29/04

BROOKS KUSHMAN P.C.

1000 Town Center, 22nd Floor

Southfield, MI 48075

Phone: 248-358-4400

Fax: 248-358-3351

Enclosures: (1) 3 Copies of Reply Brief